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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/289,507	04/09/1999	PAUL DRZAIC	INK-039	8699

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TESTA, HURWITZ & THIBEAULT, LLP  
HIGH STREET TOWER  
125 HIGH STREET  
BOSTON, MA 02110

EXAMINER

NGUYEN, JIMMY H

ART UNIT PAPER NUMBER

2673

DATE MAILED: 12/07/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

### Application No.

09/289,507

### Applicant(s)

DRZAIC ET AL.

### Examiner

Jimmy H. Nguyen

### Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 02 September 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 66,67 and 108-125 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 66,67 and 108-125 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 7/21/04 & 9/7/04.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

### **DETAILED ACTION**

1. This Office Action is made in response to applicant's amendment filed on 09/02/2004.

Claims 66, 67 and 108-125 are currently pending in the application. An action follows below:

#### ***Drawings***

2. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the following features must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

i. Regarding to claim 111, when this claim is read together with claim 66, this claim recites each of three capsules comprising white particles, red/green/blue particles and a black particle. However, there is no such drawing, specifically figures 3E-3M reading on the elected species IV, to show each capsule comprising these three kinds of particles.

ii. Regarding to claim 112, when this claim is read together with claim 66, this claim recites each of three capsules comprising white particles, red/green/blue particles and a particle that modulates the brightness of the capsule. However, there is no such drawing, specifically figures 3E-3M reading on the elected species IV, to show each capsule comprising these three kinds of particles.

iii. Regarding to claim 113, when this claim is read together with claim 66, this claim recites each of three capsules comprising white particles, red/green/blue particles and a particle that modulates the reflectivity of the capsule. However, there is no such drawing, specifically figures 3E-3M reading on the elected species IV, to show each capsule comprising these three kinds of particles.

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iv. Regarding to claim 120, when this claim is read together with claim 67, this claim recites each of three capsules comprising white particles, cyan/magenta/yellow particles and a black particle. However, there is no such drawing, specifically figures 3E-3M reading on the elected species IV, to show each capsule comprising these three kinds of particles.

v. Regarding to claim 121, when this claim is read together with claim 67, this claim recites each of three capsules comprising white particles, cyan/magenta/yellow particles and a particle that modulates the brightness of the capsule. However, there is no such drawing, specifically figures 3E-3M reading on the elected species IV, to show each capsule comprising these three kinds of particles.

vi. Regarding to claim 122, when this claim is read together with claim 67, this claim recites each of three capsules comprising white particles, cyan/magenta/yellow particles and a particle that modulates the reflectivity of the capsule. However, there is no such drawing, specifically figures 3E-3M reading on the elected species IV, to show each capsule comprising these three kinds of particles.

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the

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drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. The replacement sheet(s) should be labeled "Replacement Sheet" in the page header (as per 37 CFR 1.84(c)) so as not to obstruct any portion of the drawing figures. If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

***Claim Rejections - 35 USC § 112***

3. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

4. Claims 111-113 and 120-122 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

Regarding to claims 111-113, when these claims are read together with claim 66, these claims recite each of three capsules comprising white particles, red/green/blue particles, and a black particle, a particle that modulates the brightness of the capsule or a particle that modulates the reflectivity of the capsule. The disclosure, when filed, specifically the information relating to the elected species IV as illustrated by figures 3E-3M, does not fairly contain each capsule comprising these three kinds of particles. The closest disclosure, specifically the embodiment as illustrated by figure 3M, teaches a capsule including white particles, red particles and cyan

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particles. Further, see the drawing objection above. Accordingly, the original disclosure does not fairly convey to one of ordinary skill in the art that inventor(s) had in their possession the invention of new claims 111-113.

Regarding to claims 120-122, when these claims are read together with claim 66, these claims recite each of three capsules comprising white particles, cyan/magenta/yellow particles, and a black particle, a particle that modulates the brightness of the capsule or a particle that modulates the reflectivity of the capsule. The disclosure, when filed, specifically the information relating to the elected species IV as illustrated by figures 3E-3M, does not fairly contain each capsule comprising these three kinds of particles. The closest disclosure, specifically the embodiment as illustrated by figure 3M, teaches a capsule including white particles, red particles and cyan particles. Further, see the drawing objection above. Accordingly, the original disclosure does not fairly convey to one of ordinary skill in the art that inventor(s) had in their possession the invention of new claims 120-122.

### ***Double Patenting***

5. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

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6. Claims 66, 67, 108, 109, 114-118 and 123-125 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 76, 77, 81, 82, 84-86, 88, 89 and 91-93 of copending Application No. 10/145,861.

Although the conflicting claims are not identical, they are not patentably distinct from each other because the claimed invention of the claims of the pending application contains a version, which is **broader** than the version of the invention defined in the claims of the copending Application.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented. It is noted that the conflicting claims of the copending Application 10/145,861 were allowed.

7. Claims 110-113 and 119 and 122 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 76, 77, 81 and 88 of copending Application No. 10/145,861 in view of Jacobson et al. (USPN: 5,961,804), hereinafter Jacobson.

Regarding to these claims, as discussed in the rejection above, all of the claimed limitations of the claims of the pending application are read in the conflicting claims of the copending application except that the suspending fluid is dyed (see claims 110 and 119), and at least one of the first, second and third particle capsules further comprises a black particle (see claims 111 and 120), a particle that modulates the brightness of the capsule (see claims 112 and 121) or a particle that modulates the reflectivity of the capsule (see claims 113 and 122). However, Jacobson discloses a related multicolor electrophoretic display element comprising comprises a plurality of microcapsules (320) (see figs. 4B and 6B), each comprising a suspending fluid (405). Jacobson also teaches the suspending fluid being substantially clear (col.

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8, lines 35-36) or dyed (see claim 1, last line), so as to improve the image color of the display elements. Jacobson also teaches each capsule including a particle (spheres 620, fig. 6B) that modulates the brightness and the reflectivity of the capsule, so as to produce a brighter pixel and improve the image quality (see col. 12, lines 11-17). Furthermore, as noting in fig. 6B, Jacobson also teaches each capsule including three kinds of particles (410, 610, 620) and one of the particles being black (a black microparticle 410, col. 8, lines 37-38), thereby improving the color image quality. Therefore, it would have been obvious to a person of ordinary skill in the art at the time of the invention was made to substitute the dyed suspending fluid of Jacobson for the suspending fluid of the invention of the claims 81 and 88 of the copending application, or to provide a black particle or a particle that modulates the brightness and the reflectivity of the capsule in each capsule of the invention of the claims 76 and 77 of the copending application, in view of the teaching in the Jacobson reference, because this would improve the image color of the display, produce a brighter pixel and improve the color image quality.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented. It is noted that the conflicting claims of the copending Application 10/145,861 were allowed.

### *Conclusion*

8. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO**



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MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jimmy H. Nguyen whose telephone number is (703) 306-5422. The examiner can normally be reached on Monday - Thursday, 8:00 a.m. - 5:00 p.m..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Bipin Shalwala can be reached at (703) 305-4938. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

JHN  
December 1, 2004



Jimmy H. Nguyen  
Primary Examiner  
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